

REMARKS/ARGUMENTS

The Office Action mailed August 15, 2006 has been reviewed and carefully considered. Claims 1, 3-18, and 20 are pending in this application, with claims 1, 14, and 18 being the only independent claims. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claim Amendments

Claim 1 is amended to incorporate the limitations of dependent claim 3 and to recite that the transparent portion of the exterior portion is on a front side of the package. This is disclosed in Fig. 6 of the original specification. Dependent claim 3 is amended to be depend from independent claim 14. Dependent claim 5 is amended to clarify that the at least one of said artificial fingernails in the further display compartment is observable through the transparent portion. Support for this limitation is found in Fig. 6. Independent claim 14 is rewritten to include limitations similar to dependent claim 5. Support for the limitations added to claim 14 is found in Fig. 6. Independent claim 18 is amended to include limitations similar to dependent claim 3.

Dependent claim 19 is canceled without prejudice or disclaimer.

Rejection of Claims under 35 U.S.C. §§102 and 103

Claims 1, 4, 5, 9-10 and 13-17 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,791,482 (Murphy).

Claims 11-12, 18 and 20 stand rejected under 35 U.S.C. §103 as being unpatentable over Murphy.

Claims 6-8 stand rejected under 35 U.S.C. §103 as unpatentable over Murphy in view of U.S. Patent No. 4,106,614 (Aylott).

Claims 3 and 19 stand rejected under 35 U.S.C. §103 as unpatentable over Murphy in view of U.S. Patent No. 4,282,975 (Ovadia).

Independent claim 1 now incorporates the limitations of dependent claim 3 and recites “a transparent portion facing a front of said package” and “means for retaining said at least two different ones of said artificial fingernails such that at least one of a c-curve and an arch height of each of said at least two different ones of said artificial fingernails is observable outside of said package through said transparent portion of said exterior portion, wherein said means for retaining comprises a holding material having slits in which said at least two of said artificial fingernails are respectively received”.

As stated in MPEP §2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

None of these three criteria are met. Even though sponges are known for holding jewelry from Ovadia, the combined teachings of Ovadia and Murphy fail to disclose teach or suggest receiving artificial fingernails in slits of a holding material so that the c-curve of the nails is observable outside of said package through said transparent portion of said exterior portion, the transparent portion facing a front of the package, as expressly recited in independent claim 1. Murphy discloses a package for artificial nails with a display compartment 25 holding a

fingernail 28. Murphy further discloses a tapered cavity 35 for receiving a user's thumb so that the thumb is visible with the fingernail 28 so that a user can determine size compatibility between the thumbnail and the displayed artificial nail (see col. 4, lines 1-12). As shown in Fig. 1, the compatible size is determined while viewing the top of the fingernail. Accordingly, there is no teaching or suggestion that a c-curve of the fingernail should be viewable through a transparent portion facing the front of the package. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome in which that which only the inventor taught is used against its teacher." *See* W.L. Gore & Assocs. V. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Only the present invention teaches the desirability of showing the c-curve or arch height to a prospective customer. The prior art Murphy discloses only that the top view of the artificial nail is important. Ovadia discloses sponges for holding jewelry and therefore teaches nothing about artificial nails. Thus, the combination of Murphy with Ovadia fails to teach or suggest "means for retaining said at least two different ones of said artificial fingernails such that at least one of a c-curve and an arch height of each of said at least two different ones of said artificial fingernails is observable outside of said package through said transparent portion of said exterior portion, wherein said means for retaining comprises a holding material having slits in which said at least two of said artificial fingernails are respectively received", as expressly recited in independent claim 1.

Independent claim 14 is amended to recite "a first compartment for displaying at least two of said artificial fingernails having a plurality of different arch heights, wherein each of said at least two artificial fingernails has a c-curve, and wherein the c-curve of said at least two of said artificial fingernails is observable from outside said front of said package, and said package

having a second compartment with at least one of said artificial fingernails arranged so that a top of said at least one fingernail is observable from outside said front of said package". This limitation is based on dependent claim 5 but additionally requires that both the c-curve of the nails in the first compartment and the top of the nail in the second compartment are viewable front a front of the package.

Murphy fails to disclose this limitation because Murphy shows that only the tops of nails are observable from the front of the package.

Independent claim 18 is amended to include limitations similar to those of independent claim 1 and should be allowable for at least the same reasons.


In view of the above amendments and remarks, independent claims 1, 14, and 18 are deemed to be allowable over the prior art of record.

Dependent claims 4-13, 15-17, and 19-20, are deemed to be allowable for at least the same reasons as are independent claims 1, 14, and 18, as well as for the additional recitations contained therein.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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